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10/087,697	03/01/2002	Richard Franz	D-2998	4890

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EXAMINER

SANDERS JR, JOHN R

ART UNIT

PAPER NUMBER

3737

DATE MAILED: 05/08/2003

4

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/087,697

Applicant(s)

FRANZ ET AL.

Examiner

John R. Sanders

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 01 March 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 March 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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## DETAILED ACTION

### *Inventorship*

1. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

### *Drawings*

2. New corrected drawings are required in this application because the submitted drawings are informal. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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3. Claims 1, 3-6, 11-14, 16-23 and 25-27 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,993,001 to *Bursell et al.*
4. Regarding claims 1 and 12, *Bursell et al.* discloses (in FIG. 1) a remote exam module (12) including a plurality of optical devices (32, 34) connected to a controller in the form of computer (30); a communications link (22); and a diagnostic center (20A or 20B) comprising a database and exam console (see abstract).
5. Regarding claim 3, *Bursell et al.* discloses computer means for analyzing the data and diagnosing conditions (col. 2: 28-31; col. 2: 45-51).
6. Regarding claims 4 and 5, *Bursell et al.* discloses the information comprising a combination of fundus information and retinal information (abstract; col. 11: 6-11).
7. Regarding claim 6, *Bursell et al.* discloses real-time teleconferencing (col. 2: 32-38).
8. Regarding claim 11, *Bursell et al.* discloses digital imaging devices (col. 3: 4-12).
9. Regarding claims 13 and 14, *Bursell et al.* discloses the storage of patient image files as a patient record (col. 6: 18-26) and discloses retrieving a patient record from a database (col. 6: 48-54).
10. Regarding claim 16, *Bursell et al.* discloses sharing patient medical information, including diagnosis, between the physician/technician and the patient.
11. Regarding claims 17-23 and 25-27, *Bursell et al.* discloses the limitations as described above as applied in a formulaic method.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claim 2 is rejected under 35 U.S.C. §103(a) as being unpatentable over *Bursell et al.* in view of U.S. Patent No. 6,027,217 to *McClure et al.*

*Bursell et al.* discloses a telecommunications link but does not disclose expressly using the Internet to transmit information. *McClure et al.* discloses a remote exam module connected to a central diagnosis unit/database via the Internet (abstract; FIG. 4).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify the invention of *Bursell et al.* to conduct data transfer over the Internet. The suggestion/motivation for doing so would have been to use a pre-existing network with potentially global transmission capability (see *McClure et al.*, col. 4: 37-56). *Bursell et al.* relies primarily on high-bandwidth transmissions and therefore limits the disclosed network to dedicated LAN or satellite links. However, *Bursell et al.* provides support for using lower-bandwidth connections (col. 8: 29-35), and also mentions specifically “the present invention can also be practiced with another suitable network system...that has sufficient bandwidth...” (col. 6: 57-60). The advancements in Internet bandwidth, high-speed Internet connections and Internet teleconferencing present at the time of the invention are supported by *Bursell et al.* and expressly disclosed in *McClure et al.*

Therefore, it would have been obvious to combine the *McClure et al.* with *Bursell et al.* to obtain the invention as specified in claim 2.

13. Claims 7-9 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Bursell et al.* in view of U.S. Patent No. 6,523,954 to *Kennedy et al.*

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*Bursell et al.* discloses the remote exam modules as described above but does not disclose expressly collecting patient history data via a touch screen or voice-activated input unit. *Kennedy et al.* discloses a remote data entry device for receiving patient information including a touch screen or employing voice recognition software (col. 8: 12-38).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify *Bursell et al.* to include data entry by means of a touch screen or voice-activated input. The suggestion/motivation for doing so would have been to use these devices to facilitate and expedite the data entry phase of the examination.

Therefore, it would have been obvious to combine *Kennedy et al.* with *Bursell et al.* to obtain the invention as specified in claims 7-9.

14. Claims 10, 15 and 24 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Bursell et al.* in view of U.S. Patent Application Publication No. 2001/0032100 A1 to *Mahmud et al.*

*Bursell et al.* discloses a central patient database but does not disclose expressly accessing patient records through a World Wide Web interface. *Mahmud et al.* discloses a medical record system that is accessible by authorized patients over the Internet (par. 40).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use an Internet-accessible patient record system with the remote testing system of *Bursell et al.* The suggestion/motivation for doing so would have been to provide the patient with a means of reviewing his or her medical information either at the remote exam module or at a location removed from the remote exam module.

Therefore, it would have been obvious to combine *Mahmud et al.* with *Bursell et al.* to obtain the invention as specified in claims 10, 15 and 24.

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*Conclusion*

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. *De la Huerga et al.* ('889) discloses a system and method for collecting and archiving patient records using HTML.

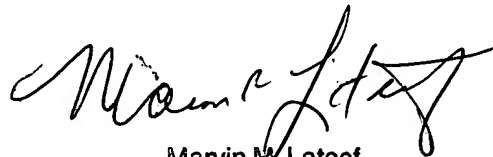
Any inquiry concerning this communication or earlier communications from the examiner should be directed to John R. Sanders whose telephone number is (703) 305-4974. The examiner can normally be reached on M-F 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marvin M. Lateef can be reached on (703) 308-3256. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3590 for regular communications and (703) 308-0758 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.



jrs  
April 28, 2003



Marvin M. Lateef  
Supervisory Patent Examiner  
Group 3700